In the Supreme Court of the United States

OCTOBER TERM, 1971

No. 71-485

ROBERT GOTTSCHALK, ACTING COMMISSIONER OF PATENTS, PETITIONER

v.

GARY R. BENSON AND ARTHUR C. TABBOT

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

REPLY MEMORANDUM FOR THE PETITIONER

The patent claims in issue here are not limited to any particular use, apparatus or machinery. Rather, as respondents admit, they broadly define exclusive rights to a process which "can be performed on most general purpose stored program computers * * * for converting signals encoded in the binary coded decimal (BCD) notation into signals encoded in the ordinary binary notation" (Resp. Br. p. 1). Although respondents assert that they intend to use the proce-

dures claimed for the purpose of switching telephone dial signals, this intended use is not an element of the claims. Indeed, the court below expressly observed that the claims "are directed solely to the art of data-processing itself" rather than to any particular technology (Pet. 25). Thus it described the two claims as a series of steps in a mathematical process, recorded for use in a computer by manipulating signals corresponding to "1" and "0", the two elements of binary notation (Pet. 28, 30).

Respondents also assert that they could have claimed "wired circuitry" as a means of embodying the logical operations required to apply the mathematical procedures they claim. But the short answer is that respondents did not claim any such apparatus. Instead they claimed a process which would be infringed by any application in a general purpose computer of the mathematical procedures described. Moreover, respondents' argument fails to distinguish between an application which claims a tangible apparatus, and one which claims the mathematical process it implements. Under the congressional scheme and the decisions of this Court, mathematical concepts and procedures are part of the common intellectual patrimony that every man has the right to apply in old ways and new on existing and future apparatus. *O'Reilly* v. *Morse*, 15 How. 62, 113. Such apparatus may itself be patentable if it does not duplicate previously known inventions. But even if a wired circuit or machine designed to carry out the steps claimed here is patentable, we submit that the procedures themselves are not.

If the issue of patentability of computer programs presented here is not resolved now, the Patent Office must in the future issue patents on such applications regardless of the effect on the developing computer industry, the public, and the patent system. This important question must, therefore, be resolved by this Court either now or else at the end of what could be an extended series of patent infringement suits. In this case the Patent Office sought to comply responsibly with this Court's mandate in *Graham* v. *John Deere Co.*, 383 U.S. 1, 18, that it should apply the high standards reflected in the patent decisions of the federal courts. The legal issue presented by the contrary decision of the court below is not one that will be illuminated by awaiting infringement litigation. As long as the question of the patentability of computer programs remains unresolved, however, a cloud will remain over the development of a new and vital sector of intellectual activity and of the economy. And, as the *Deere* decision pointed out, the courts will be unnecessarily burdened and the patent system debilitated by the uncertainty attending infringement litigation. *Ibid.* The issue should be resolved now. Compare *Brenner* v. *Manson*, 383 U.S. 519.

Respectfully submitted.

ERWIN N. GRISWOLD,
Solicitor General.

DECEMBER 1971.

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